

BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: RONALD JOHN ROSENBERGER Conf. No. 2238
Application No.: 10/822,051 Art. Unit: 3728
Filing Date: 04/10/2004 Examiner: John T. Kavanaugh

Title: **SCENTED SHOE SOLES**

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(Name of Appellant, assignee, or Registered Representative)

/Guy Kevin Townsend/

(Signature)

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**PETITION TO HAVE FIGURES ACCEPTED FORMALLY TO PROCEED
WITH PENDING APPEAL**

Dear Sir:

Appellant files this Petition relating to 1002.02(c) Petitions and Requests Decided by the Technology Center Directors 3640, specifically 1002.02(C)4. Petitions under 37 CFR 1.113 relating to objections or requirements made by the examiners, and accompanying fee under 37 CFR 1.17(h), in connection with Appellant's filing of a Revised Appellant's Brief on Appeal in response to each and every issued raised in the Notification of Non-Compliant Appeal Brief, mailed April 16, 2009, now due June 16, 2009, with a one-month

extension and fee submitted herewith. Appellant has amended the Appeal Brief to address the issues raised by the Examiner and hereby petitions the Petitions Branch to Figure 1 entered and accepted formally to proceed with the Appeal. The Examiner has requested that a petition be filed to accept formal aspects, such as under 37 CFR 1.183(a), of Figure 1 in order to proceed with Appeal. Appellant/ Petitioner provides the following Statement of Facts, Points Reviewed and Action Requested for this Petition to be fully considered and acted on by the Director.

1. Statement of Facts

Statement of Status of Amendments and Appeal

The Examiner did not enter Appellant's Amendment under 37 CFR 116, filed June 27, 2006, in response to the final Office Action of March 27, 2006, as indicated in an Advisory Action of record but not received by Appellant in the mail. The Examiner maintained his rejections in the final Office Action as indicated in the Advisory Action.

Figure 1 and Claims 1-7 and 9-21 are pending on Appeal as amended in Applicant's response submitted March 10, 2006, to the Examiner's November 14, 2005, non-final Office Action. Figure 1 is provided as Appendix B.

Summary of Claimed Subject Matter

The presently claimed invention is specific to a shoe sole for a shoe comprising at least one scented plug or insert (as supported, e.g., at pages 3-7 of the specification). The following table provides independent claim 1 and its corresponding support in the specification.

<u>Independent claim</u>	<u>Specification Support</u>
1. A shoe sole for a shoe comprising at least one scented material/formulation compound as a component of the shoe	p. 3-7: The present invention involves scenting the shoe's sole material/formulation compound(s) with at least one novelty scent or fragrance. The term "novelty scented shoes" is

<p>sole or as provided in a shoe sole plug or insert, where said scented material/formulation compound comprises at least one scent or fragrance</p> <p>(A) where said scented material/formulation compound gives off a desired aroma when said shoe sole is at rest;</p> <p>(B) where said scented material/formulation compound gives off a desired aroma when said shoe sole is in normal use due to friction, heat buildup, and wear; or</p> <p>(C) where said novelty scented material/formulation compound gives off a desired aroma when normal wear of said shoe sole exposes fresh surface area of said scented material/formulation compound, and wherein said desired aroma comprises a salient, distinctive, and marketable feature of said shoe.</p>	<p>herein defined as shoes comprising scented sole material/formulation compound(s).</p> <p>In many scent related disclosures not having anything to do with the present invention, scent is used to mask offensive odors, such as room deodorizers. This is not the case with the present invention, where the unique aroma due to the novelty scent or fragrance added to the material/formulation compound is a salient, distinguishing, and marketable feature of the shoe comprising the novelty scented shoe sole, and may comprise any desired novelty scent or fragrance. The shoe comprising the novelty scented shoe sole gives off a unique aroma when the shoe is at rest, and when the shoe is in use. Friction, heat buildup, and wear due to use is an effective means of releasing the aroma; and wear of the novelty scented shoe sole serves to expose fresh surface area of the novelty scented material/formulation. Wear and tear of a given shoe has the greatest impact on the sole of the shoe, and it is this wear and tear aspect that enable special dynamics of the disclosed sole to emerge. For purposes of this disclosure, the term "novelty scented shoes" refers to shoes comprising novelty scented shoe soles.</p>
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Grounds of Rejection Relating to Figure 1

The Examiner objects to the specification and drawings under 37 CFR 1.83(a) and 35 USC 132 as failing to have figure description added to the specification and for adding new matter as presented in paragraphs 1-3 on pages 2-4 of the final Office Action, asserting that the figures must have a corresponding description in the specification, include all of

the limitations of the claims, be supported by the specification, and that new drawings should be provided showing each of the claimed features of the invention, including “shoe sole,” “scented compound,” “visual aspect,” “two or more plugs or inserts”.

37 CFR 183(a) states that (*emphasis added*):

§ 1.83 Content of drawing.

(a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box). In addition, tables and sequence listings that are included in the specification are, except for applications filed under 35 USC 371, not permitted to be included in the drawings.

2. Points to be Reviewed

Appellant/Petitioner submitted Figure 1 in the response filed March 14, 2006, to the non-final Office Action of November 11, 2005, specifically meeting the requirements of 37 CFR 1.83(a), where Appellant/Petitioner provided Figure 1, as fully supported by the present specification (e.g., as shown below). Figure 1 clearly has corresponding description in the specification, includes all of the limitations of the claims, and shows each of the claimed features of the invention, including “shoe sole,” “scented compound,” “visual aspect,” “two or more plugs or inserts”. In particular, this Figure 1 shows, according to 37 CFR 1.83(a) as cited by the Examiner, “conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation. Appellant/Petitioner respectfully points out that the provided Figure 1 shows conventional features in the form of a graphical drawing symbol, according to 183(a), and submits that this Figure meets 37 CFR 1.183(a).

With regard to the new matter rejection, Appellant/Petitioner respectfully points out that the terms and description supporting the provided Figure 1 for the terms and drawing of “shoe sole”, “scented compound”, “receptacle”, and “scented plug or insert” are fully

supported by the original and present specification, inter alia, as follows, throughout pages 6-23 of the present specification:

SUMMARY OF THE INVENTION

The present invention involves scenting the shoe's sole material/formulation compound(s) with at least one novelty scent or fragrance. The term "novelty scented shoes" is herein defined as shoes comprising scented sole material/formulation compound(s).

In many scent related disclosures not having anything to do with the present invention, scent is used to mask offensive odors, such as room deodorizers. This is not the case with the present invention, where the unique aroma due to the novelty scent or fragrance added to the material/formulation compound is a salient, distinguishing, and marketable feature of the shoe comprising the novelty scented shoe sole, and may comprise any desired novelty scent or fragrance. The shoe comprising the novelty scented shoe sole gives off a unique aroma when the shoe is at rest, and when the shoe is in use. Friction, heat buildup, and wear due to use is an effective means of releasing the aroma; and wear of the novelty scented shoe sole serves to expose fresh surface area of the novelty scented material/formulation. Wear and tear of a given shoe has the greatest impact on the sole of the shoe, and it is this wear and tear aspect that enable special dynamics of the disclosed sole to emerge. For purposes of this disclosure, the term "novelty scented shoes" refers to shoes comprising novelty scented shoe soles.

The intended purpose of embellishing shoe soles with novelty scent or fragrance is to provide a marketable feature to end-users. For example, nine and ten year old girls could respond favorably, if not preferably, to athletic shoes that feature cherry or strawberry scented soles. A golfer could get a kick out of golf shoes that smell like turf, or better yet, hundred dollar bills. The purpose of scent is to provide an additional reason for a given purchaser to select the scented product over another that isn't scented. A dream scenario for a manufacturer offering athletic shoes comprising novelty scented soles would be where a given purchaser struggles with whether to buy the vanilla scented shoes, versus the cherry scented shoes, versus the orange scented shoes, where said purchaser is totally ignoring a competitor's unscented athletic shoes.

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DETAILED DESCRIPTION OF THE INVENTION

[Page 8]

The disclosed shoe comprises any footwear, such as any athletic or exercise shoes, any work or hunting boots, any casual shoe or casual boots, any dress shoe or dress boots, any open-toed shoes or sandals, any slippers, etc.

The scenting agent(s) for the novelty scented shoe soles may comprise any scent producing agent(s) such as those comprising, but not limited to, water, oil, or glycol

soluble scents, in any range of scent or fragrance concentration that achieves the desired aesthetic result. The aroma of the scenting agent(s) may comprise any desired aroma, such as citrus scents (lemon, orange, etc.), fruity scents (coconut, cherry, etc.), spice scents (cinnamon, vanilla, etc.), to the earlier mentioned less usual scenting aromas (grass, money, etc.). Also, the scenting agent(s), as used in the novelty scented shoe soles, may comprise any kind(s) of pheromone(s) in place of, or in addition to, the abovementioned at least one novelty scent or fragrance.

Known construction materials for shoe soles comprise different types of rubber, treated leathers, and other materials synthetic in nature. The disclosed novelty scented shoe soles can comprise the use of any suitable construction materials.

The shoe soles may be scented or fragranced by any possible means, such as where at least one scent or fragrance is added as an ingredient to the shoe sole material/formulation compound; or where the material/formulation compound is laced with encapsulated or microencapsulated scent(s) or fragrance(s), and/or pheromone(s), either with or without the basic material/formulation compound being scented itself; or even where a finished shoe sole, or the pre-fabrication sole material(s), such as leather or rubber sole material, is coated with or steeped in a scenting or fragrancing means, all of which, for purposes of this disclosure, are to be known as novelty scented sole material/formulation compounds.

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[page 10]

Another means of scenting the shoe soles is to use novelty scented plugs or inserts. For the sake of disclosure, a novelty scented plug or insert may comprise pheromones in place of, or in addition to, novelty scent or fragrance; may comprise other attributes in addition to novelty scent or fragrance and/or pheromones, that will be discussed later; or may even comprise said other attributes in place of said novelty scent or fragrance and/or pheromones.

A novelty scented plug or insert can be installed on the disclosed shoe sole that comprises novelty scented material/formulation compound, and/or pheromones, or it may be installed on shoe soles not comprising any of the abovementioned attributes. What is important is that the shoe sole comprises at least one void anywhere on the surface of the sole where the void comprises a receptacle that is intended for and allows for the insertion of at least one novelty plug or insert. A clarification is in order here. While the term "anywhere on the surface" mostly pertains to the wearable surface of the shoe sole, a void *can* occur on a non-wearing surface of the sole, where the novelty scented plug exists to emit scent *sans* wear. Such would comprise a void or receptacle for a novelty plug or insert on the side of the sole, or even a void or receptacle around the non-wearing circumference of the entire shoe sole, and/or around the non-wearing circumference of the heel portion of the sole, and/or around the non-wearing circumference of the non-heel portion of the sole, any of which that are visible from above when the shoe is worn on the user's foot.

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A given novelty scented plug or insert, and its corresponding void or receptacle can comprise any shape, design, directional orientation, size, or depth. Also, a plug or insert can comprise a shape that fills a void in the form of a groove, channel, or crevice comprising any shape, design, design pattern, directional orientation, size, or depth.

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The novelty scented plug may be scented using any of the means disclosed earlier for the scented material/formulation compound. The novelty scented plug or insert can comprise any color, or if desired, colors. The novelty scented plug or insert can comprise any material/formulation compound; however, the material/formulation compound that is ultimately used should be carefully considered, because if the material/formulation compound used for a novelty scented plug or insert, especially in the wearable surface, is too hard compared to the shoe sole material/formulation compound, excess noise and/or friction can result. If the material/formulation compound is too soft, then excess debris can get lodged in the material/formulation compound. While best bets for the novelty-scented plug or insert material/formulation compound are compounds similar, if not identical, to the material/formulation compounds used in the actual shoe sole. For the sake of disclosure, the novelty scented plugs or inserts can comprise material formulation/compounds identical to, similar to, or different from the material formulation/compound comprising the shoe sole.

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The novelty scented plug or insert may comprise a plug or insert comprising multi-sectional construction, where a singular novelty plug or insert comprises two or more sections, where any one given section, or even two or more sections, can be oriented either along the depth of the novelty plug or insert, and/or along or across the surface area that is visible on the shoe sole after installation (where the two or more sections are side by side; or, where two or more sections are side by side, over top of a third section that is hidden underneath). Furthermore, any one given section can comprise any one, or any combination or permutation comprising more than one, of the following attributes: at least one material compound; at least one color; at least one novelty scent and/or fragrance; at least one pheromone; at least one novelty visual aspect; or at least one smoke releasing means. The combinations are endless and versatile. For instance, a singular novelty plug or insert comprising two sections (a top and bottom section) along the depth can have a cherry scented red glitter section adjacent to the wear surface of a new shoe sole; then, when the sole and the novelty plug or insert both wear down, the bottom section of the novelty plug or insert comprising a lemon scented yellow glitter section is revealed. Likewise, the top section of a novelty plug or insert can comprise pink glitter that smells like bubblegum, or be just an unscented top section, that wears down to the abovementioned smoke releasing mechanism that gives off an orange smoke.

Making the novelty scented plugs or inserts may comprise solid plugs or inserts that are formed by any forming means including plugs or inserts that comprise any means of molding, casting, die cutting, extruding and cutting, molding and cutting, casting and cutting, etc. For example, a given plug or insert may be injection molded into the desired shape.

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Voids in the soles may occur using any void creating means. For example, in the case of an athletic shoe sole, such may be attained by having the void(s) molded along with the other design features of the sole during the manufacturing process, or the void(s) can be created by void creating means such as milling, drilling, etc. It is intended that a given novelty scented plug or insert is designed, or is able to be modified, to be inserted in a corresponding void or receptacle of the shoe sole by any possible inserting or installing means, either automatically by machine, or by hand with or without the use of tools. Also, it is intended that a given novelty scented plug or insert can be secured in the corresponding void or receptacle of the shoe sole using any securing means, whether said novelty scented plug or insert is glued in, pressure-fitted, heat set, screwed in, set using grooves or serrations on the plug and/or the shoe sole, held by elastic means, etc.

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Finally, it could possibly be desirable that a given novelty plug or insert be removed from the void of the disclosed shoe sole for whatever reason, such as after a plug comprising smoking means has deployed, and the end user wishes to install a new plug comprising smoking means. Any removing means may be contemplated as an antidote to overcome prior installation, even if such removing means are as basic as using tweezers, a drill or a dremel tool to remove the novelty plug or insert, or remnants of a deployed novelty plug or insert comprising smoking means; however, removal may be as simple as where a novelty plug or insert comprising a scented and sparkly “O” ring around the circumference of the sole, and comprising qualities similar to a rubber band, is simply stretched and removed, and replaced just as easily.

Accordingly, Appellant asserted and maintains that Figure 1 is fully supported by the present specification, the aspects of Figure 1 clearly have a corresponding description in the specification, and showing each of the claimed features of the invention, including “shoe sole,” “scented compound,” “visual aspect,” “two or more plugs or inserts”.

Appellant submits that this rejection is in error and should be reversed.

3. Action Requested

In view of the above arguments and evidence of record, Appellants request that this petition be granted, such that Figure 1 is formally accepted to the extent that Appellant can proceed with the pending Appeal.

The Director, the Examiner, or the Examiner's SPE are invited to contact Appellant/Petitioner with any questions or comments.

Respectfully submitted,

/Guy Kevin Townsend/

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Date: May 29, 2009

CLAIMS ON APPEAL

1. (Previously Amended) A shoe sole for a shoe comprising at least one scented material/formulation compound as a component of the shoe sole and/or as provided in a shoe sole plug or insert, where said scented material/formulation compound comprises at least one scent or fragrance

- (a) where said scented material/formulation compound gives off a desired aroma when said shoe sole is at rest;
- (b) where said scented material/formulation compound gives off a desired aroma when said shoe sole is in normal use due to friction, heat buildup, and wear; or
- (c) where said novelty scented material/formulation compound gives off a desired aroma when normal wear of said shoe sole exposes fresh surface area of said scented material/formulation compound,

and wherein said desired aroma comprises a salient, distinctive, and marketable feature of said shoe.

2. (Previously Amended) The shoe sole of claim 1, further comprising including where said scented material/formulation compound comprises at least one desired pheromone in addition to, or in place of, said at least one scent or fragrance.
4. (Previously Amended) The shoe sole of claim 1, further comprising including where said scented material/formulation compound comprises at least one smoking means in addition to, or in place of, said at least one scent or fragrance and/or at least one pheromone.
5. (Original) The shoe sole of claim 1, further comprising including where said shoe comprises materials that are colored in accordance to the scent of said shoe sole.
6. (Original) The shoe sole of claim 1, further comprising including where a given pair of shoes comprise a mixed set, where each shoe sole in said given pair comprises a different scent.

7. (Previously amended) The shoe sole of claim 1, further comprising including where said shoe sole comprises at least one void anywhere on the outside surface of said shoe sole, where said void comprises a receptacle that is intended for and allows for the insertion of at least one scented plug or insert, where said void comprises a hole of any shape, design, directional orientation, size, or depth, and/or a groove, channel, or crevice comprising any shape, design, design pattern, directional orientation, size, or depth,
8. (Previously amended) The shoe sole of claim 6, further comprising including where said shoe sole comprising said at least one void anywhere on the outside surface of said shoe sole, where said void comprises a receptacle that is intended for and allows for the insertion of at least one scented plug or insert, does not comprise said at least one scented material/formulation compound, and/or does not comprise at least one pheromone, and/or does not comprise at least one smoking means.
9. (Canceled)
10. (Previously Amended) The void of claim 6, further comprising including where said void can accommodate said at least one scented plug or insert comprising any embodiment of an "O" ring around the non-wearing circumference of the entire shoe sole, and/or around the non-wearing circumference of the heel portion of said shoe sole, and/or around the non-wearing circumference of the non-heel portion of said shoe sole; or where said "O" ring is in or on the wear surface of said shoe sole.
11. (Previously Amended) The void of claim 6, further comprising including where said void can accommodate two or more plugs or inserts, either along the depth of said void, side-by-side along/across the opening gap of said void, or both.
12. (Previously Amended) The scented plug or insert of claim 6, comprising where said plug or insert comprises any shape, design, size or depth, comprising where said plug or insert comprises any material composition, comprising where said plug or insert comprises any color or any colors, and comprising where said plug or insert is designed for or is able to be modified to be inserted, installed and/or secured in said void by any possible inserting, installing or securing means; further comprising

including where said plug or insert is removable from said void using any removing means.

13. (Previously Amended) The scented plug or insert of claim 11, comprising where said plug or insert may be formed by any forming means, where said any forming means comprises any means of molding, casting, die cutting, extruding and cutting, molding and cutting, casting and cutting, etc.
14. (Previously Amended) The scented plug or insert of claim 11, comprising where said plug or insert comprises semi-solids that are introduced into said void using any void-filling means, where said any void-filling means comprises any means of pouring, pumping, injecting, or spraying, etc.
15. (Previously Amended) The material composition of claim 11, further comprising including where said material composition comprises at least one scent or fragrance and/or pheromone.
16. (Previously Amended) The material composition of claim 11, further comprising including where said material composition comprises at least one visual aspect, where said visual aspect comprises any or interesting appearance items including items that are reflective, refractive, sparkling, shining, holographic, jewel-like, pearlescent, fluorescent, glow-in-the dark, etc., where said visual aspect does not produce light and does not comprise the use of a chemical reaction that produces light.
17. (Original) The material composition of claim 11, further comprising including where said material composition comprises at least one smoking means.
18. (Previously Amended) The scented plug or insert of claim 11, comprising where a singular said scented plug or insert comprises, in addition to at least one material composition, any one, or any combination or permutation comprising more than one, of the following attributes: at least one color; at least one scent and/or fragrance; at least one pheromone; at least one visual aspect; or at least one smoking means.
19. (Previously Amended) The scented plug or insert of claim 11, further comprising including where said scented plug or insert comprises a plug or insert comprising multi-sectional construction, where said plug or insert comprising said multi-sectional

construction comprises two or more sections, where any one given section, or more than one given sections comprising said two or more sections can be oriented either along the depth of said scented plug or insert comprising multi-sectional construction, and/or along or across the surface area that is visible after installation of said scented plug or insert comprising multi-sectional construction; further comprising including where said any one given section can comprise any one, or any combination or permutation comprising more than one, of the following attributes: at least one material composition; at least one color; at least one -scent and/or fragrance; at least one pheromone; at least one visual aspect; or at least one smoking means.

20. (Previously Amended) The scented plug or insert of claim 11, comprising where said scented plug or insert may be either factory installed on said shoe during the manufacturing process; or, where said scented plug or insert may be installed on said shoe by non-factory aftermarket installers.
21. (Previously Amended) The plug or insert of claim 11, further comprising including where the installation of said scented plug or insert on said shoe by factory installers or by aftermarket installers allows for said installation to comprise any number and/or combination of different scented plugs or inserts, where differences comprising a given scented plug or insert comprising said any number and/or combination of different scented plugs or inserts can comprise any variation with regards to any one or more of the following: at least one material composition; at least one color; at least one scent and/or fragrance; at least one pheromone; at least one visual aspect; at least one smoking means; single sectional versus multi-sectional construction; etc., where the use of said different scented plugs or inserts allows for the customization of said shoe to comprise endless variants and permutations.
22. (Previously Amended) The plug or insert of claim 11, further comprising including where said scented plug or insert, and/or semi-solid scented plug or insert material, is made available and/or sold as a separately offered aftermarket item or plurality of aftermarket items, to allow customization of said shoe sole comprising said at least one void by aftermarket installers; further comprising including where said separately offered aftermarket item or said plurality of aftermarket items can be used to

customize shoes other than said shoe through the modification of said shoes other than said shoe, where said modification comprises the creation of said at least one void by any void creating means that enables installation of said separately offered aftermarket item or said plurality of aftermarket items on said shoes other than said shoe.

Application No. 10/822,051

Art Unit: 3728

Petition to Accept Drawing to Continue Appeal Brief

May 29, 2009

APPENDIX B: Figure 1

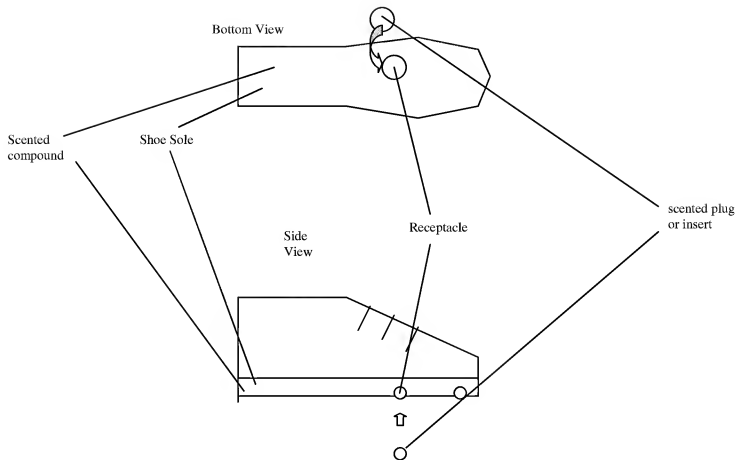


FIGURE 1